

Appln. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

REMARKS/ARGUMENTS

Claims 1-19 are pending in the application. Claims 1-19 are rejected. Claims 1, 3, 8, and 19 have been amended. No new matter has been introduced into the application. As explained in more detail below, Applicants submit that all claims are in condition for allowance and respectfully request such action.

Claim Rejections – 35 USC § 112

Claims 1-19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Office Action asserts that the criteria for defining an optimized display criteria was not adequately described in the specification. The Applicants submit that it would have been obvious to one skilled in the art at the time of the invention was discovered to utilize the numerous methods for optimizing a display. In fact, in rejecting claims 2, 6 – 7, 9, 12 – 14, and 17 – 18 (each having the limitation, or ultimately depending from a claim having the limitation of...), the Office Action asserts:

It would have been obvious to one skilled in the art, at the time of the applicants['] invention, to crop or resize images of a given animation, which when combined form a complete animation, respective to a desired displayed size for a given display device, because through such modifications[.] a better resolution of given area of interest could be achieved thus enhancing the view ability[sic] of said animation when displayed on said display".

(Office Action dated December 28, 2005; pages 7 – 8; emphasis added). Indeed, many more methods of optimizing display resolution were known in the art at the time of the Applicants' invention. In fact, in rejecting claims 1, 5, 8, 12, 15 – 16, and 19, the Office Action explicitly states that an object of an asserted patent, the '506 patent, is to:

Appln. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

provide a method and apparatus for reproducing sounds and/or images with a resolution that is optimized to the capabilities of the client computer that is decoding previously encoded sounds and/or images...[therefore, i] would have been obvious to one skilled in the art, at the time of the applicant's invention, to incorporate [the two asserted references] because through such incorporation it would allow for said animation to be displayed at a resolution optimized to the capabilities of said mobile station".

(Office Action dated December 28, 2005; page 4; emphasis added). As explained below, there are many differences between the asserted references and the subject matter of claims 1 – 19, however, it is clear that one skilled in the art at the time of the invention would have been able to define criteria for improving resolution without undo experimentation.

Moreover, the specification provides additional methods of increasing the resolution. For example, the users of the wireless handheld communication device may perform pixel-wise editing of the images in the animation. (See, e.g., Specification, page 11, lines 16 – 23; *see also* page 3, lines 12 – 14; "changing said bitmap pattern under control of the user of the communication terminal"). The Specification also discusses the resizing of images into a specific display size. (See, e.g., page 3, lines 5 – 7). Therefore, for at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection. Moreover, the Applicants retain the right to later include such limitations within the claims.

Claims 1, 8, 17, and 19 are objected to due to the lack of antecedent basis for the limitation "the terminal". The Applicants thank the Examiner for noticing this inadvertent typographical error. Through this Response and Amendment, the Applicants have removed the term "terminal". The Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

Appn. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

The Applicants have also corrected minor typographical errors in claims 1, 3, 8, 17 and 19, such as removing extraneous usage of the term "of" and properly reciting Markush groups in the claims.

Claim Rejections – 35 USC § 103

Claims 1, 5, 8, 12, 15-16, and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 5,870,683 to *Wells et al.*, ("the '683 patent") in view of U.S. Pat. No. 5,953,506 to *Kalra et al.*, ("the '506 patent"). The Applicants respectfully traverse the rejection in view of the Remarks below.

As recognized by the Office Action dated December 28, 2005, the '683 patent fails to teach the optimization of display resolution. The Office Action, however, asserts that the '506 patent meets this limitation. The Applicant's respectfully submit that the "optimization" techniques of the '506 patent do not teach, disclose, or suggest the subject matter of the rejected claims.¹ For example, claims 1, 8, 17, and 19 recite:

wherein the generating of the animation by editing of the at least one of the images and successively displaying of said sequence of images by said wireless handheld communication device optimizes display resolution of the animation generated by the terminal.

(Emphasis added). In contrast, the '506 patent does not allow a user of the wireless handheld communication device to edit an image to optimize the display resolution. Rather, the '506 patent is directed towards a scalable media delivery system where different client computers

¹ In the After-Final Response and Amendment dated March 2, 2006, the Applicants asserted the '506 patent was improperly asserted. In the instant Response and Amendment, however, the Applicants wish to distinguish the '506 patent from the claimed subject matter of the present application, and thereby withdrawal the assertion that the '506 patent was improperly asserted.

Appln. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

"may access different stream combinations according to a profile associated with each different client computer." (Col. 2, lines 37 – 39)

As explained in the '506 patent, a stream management module "will obtain a desired resolution profile from a multimedia device 22 and, based upon that desired resolution profile, select the appropriate base and additive streams from the adaptive digital data streams." (Col. 4, lines 25 – 30). There is no indication the users may edit any images or animation contained in the received data streams. (See, e.g., page 3, lines 5 – 9; "changing said bitmap pattern under control of the user of the communication terminal...transferring the changes to the remaining images of the sequence.") In fact, the '506 patent merely states that the data streams are "decoded and then displayed for the user to experience." (Col. 4, lines 31 – 32).

For at least these reasons, neither the '683 patent nor the '506 patent teach, disclose, or suggest, individually or in combination, the subject matter of claims 1, 5, 8, 12, 15-16, and 19, and any of their dependent claims. Therefore, in view of the foregoing, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 2, 6-7, 9, 12-14, and 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,870,683 to Wells et al., ("the '683 patent") and U.S. Pat. No. 5,953,506 to Kalra et al., ("the '506 patent") as applied to claims 1, 5, 8, 12, 15-16, and 19, in view of U.S. Pat. No. 6,516,202 to Hawkins et al., ("the '202 patent"), and further in view of the GIF Construction Set Professional Manual, referred to herein as GCSPM, and the GIF Construction Set Professional Homepage, referred to herein as GCSPH. The Applicants respectfully traverse the rejection in view of the Remarks below.

Appn. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

As set forth above, the primary reference, the '683 patent, does not teach, disclose, or suggest the subject matter of the rejected claims. Moreover, neither the '506 patent, the '202 patent, GCSPM nor the GCSPH, individually or collectively, teach, disclose, or otherwise suggest the subject matter of the rejected claims. For example, Claim 2 recites:

A method according to claim 1, wherein the sequence of images is displayed repeatedly for a number of times, a user of the handheld communication device set said number of times the display of the sequence of images is to be repeated.

The Office Action admits that the '683 patent does not suggest the subject matter, however, insists that it "would have been obvious to one skilled in the art to utilize an organizer with a cellular component, as taught by [the '202 patent] as a means to attain said additional resources for modification, storage and display of animation". (Office Action dated December 28, 2005; page 6).

Nowhere in the '202 patent is the concept of allowing a user to set the number of times the display of the sequence of images is to be repeated even suggested. In fact, the '202 patent is merely directed to an "organizer designed for a cellular telephone expansion" (the '202 patent, Summary of the Invention, Col. 1, line 44). Having a cellular phone with "additional features" as alleged by the Office Action does not disclose or suggest the subject matter of claim 2 or any of the rejected claims. The '202 patent is also devoid of any reference to the subject matter of claims 6-7, 9, 12-14, and 17-18.

Specifically regarding the GCSPM, it is directed to an "application for creating animated and transparent GIF files for [a] web page." (GCSPM, page 1). Nowhere does it reference a mobile phone or the limitations of independent claims 1, 8, and 17, from which the claims

Appn. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

ultimately depend. For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 3-4 and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,870,683 to Wells et al., ("the '683 patent"), U.S. Pat. No. 5,953,506 to Kalra et al., ("the '506 patent"), U.S. Pat. No. 6,516,202 to Hawkins et al., ("the '202 patent"). GCSPM and GCSPH, as applied to claims 2, 6-7, 9, 12-14 and 17-18, in view of applicant's admitted prior art, referred to herein as AAPA. The Applicants respectfully traverse the rejection in view of the Remarks below.

As set forth above, the primary reference, the '683 patent, does not teach, disclose, or even suggest the limitations of the claims from which these claims rely upon. Also, the '202 patent is merely directed to an "organizer designed for a cellular telephone expansion" (the '202 patent, Summary of the Invention, Col. 1, line 44) and the GCSPM is directed to an "application for creating animated and transparent GIF files for [a] web page." (GCSPM, page 1). In fact, the Office Action states that ALL the asserted references "fail to explicitly disclose that if said number of times the display of the sequence of images is to be repeated exceeds said predetermined number, the handheld communication device only repeats the display sequence said predetermined number of times." (Office Action dated December 28, 2005, page 10) The Office Action, however, asserts the "loop block" of GCSPM, which has an iterations argument that defines the number of times said animation will loop meets this limitation. Again, nowhere in the GCSPM is there any reference to a cellular phone or any of the limitations of the

Appn. No.: 10/078,372
Response/Amendment dated: May 16, 2006
Response to Office Action dated December 28, 2005

independent claims from which the rejected claims depend. Even combining the references would not produce the subject matter of the rejected claims.

For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

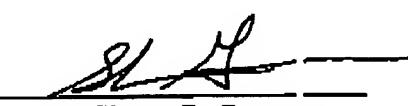
Applicant believes there is no fee due in association with the filing of this response, however, should there be any fees due the Commissioner is hereby authorized to charge any such fees or credit any overpayment of fees to Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: May 16, 2006

By:


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